

Case PA-119INFINITY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of R. Lee Roberts et al. :

Serial No.: 08/935,365

: Examiner: M. OCAMPO

Filed: September 22, 1997

: Group Art Unit: 1723

For: LOW PROFILE EXTRUDED
UNDERDRAIN

: Attn: **BOARD OF PATENT APPEALS
AND INTERFERENCES**
(APPEAL NO. - 2002 - 1430)

REQUEST FOR REHEARING

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Dear Sir:

Appellants hereby request for rehearing pursuant to 37 CFR § 1.197 (b). Appellants' grounds for rehearing are set forth below in accordance with 37 CFR § 1.197 (b).

**POINTS BELIEVED TO HAVE BEEN MISUNDERSTOOD
AND/OR MISAPPREHENDED**

Appellants' request for rehearing is specific to section IV set forth in its entirety on page 13 of the Decision on Appeal dated January 27, 2003. Appellants raise two significant issues with respect to this section of the Decision on Appeal. First, this section contains an important typographical error. Specifically, this section refers to "claims 6, 7 and 18" (See Decision on Appeal, p. 11) in connection with the instruction to the Examiner to consider whether Roberts, Berkebile and Brown '388 teach or suggest the *length* limitations recited by Appellants. Claim 18 does not include any *length* limitation. Rather, Appellants believe that the reference to Claim 18 in section IV of the Decision on Appeal should in fact be Claim 28. Appellants seek correction of

this typographical error to preclude reconsideration of the rejection of Claim 18 by the Examiner as the rejection has been reversed by this Board. ("Brown '388 and Berkebile, the respective primary references in these rejections, do not respond to the limitations in claim 18 pertaining to the three lateral members and the particular chambers formed thereby. The examiner's reliance on the underdrain block 16 disclosed by Brown '920 to overcome these deficiencies is unsound... Therefore, we shall not sustain the standing 35 U.S.C. § 103 (a) rejection of claim 18...") (See Decision on Appeal, p. 12)

The second area of misapprehension involves the instruction by the Board allowing the Examiner to reconsider whether *the exact same prior art* found by this Board to be wanting renders Claims 6, 7 and 28 unpatentable under 35 USC 103 (a). The instructions to the Examiner require him to consider "whether the extruded multi-block sections or lengths disclosed by Roberts and Berkebile, considered in conjunction with the conventional 4 foot individual block length taught by Brown '388 and admitted to be prior art [sic] the appellants (see pages 3 and 8 in the appellants' specification) would have suggested a multi-block section or length meeting the limitations" of Appellants' claims. (See Decision on Appeal, p. 13) *This was the precise issue considered by this Board in section III of the Decision on Appeal.* (See Decision on Appeal, pp. 10 and 11) This Board carefully reviewed all three of the references and expressly held: "[t]here is simply nothing, however, in the broad disclosures by Roberts and Berkebile of extruded multi-block sections or lengths intended to be cut into individual blocks which would have suggested providing the individual block disclosed by Brown '388 with a longitudinal length any longer than its disclosed about 4 foot length." (See Decision on Appeal, p. 11)

This holding is very clear, Roberts, Berkebile and Brown '388 all lack a teaching of the

length requirements of Appellants' invention. Had any of these references taught the length requirements of Appellants' claimed invention, this Board would have sustained the rejection. Rather than sustain the rejection, this Board reversed the rejection of Claims 6, 7 and 28 based on the same prior art it now seeks the Examiner to reconsider.

There is simply no reason to have the Examiner consider the very issue decided by this Board, i.e., Roberts, Berkebile and Brown '388 fail to disclose the claimed length requirements of Appellants' invention. In fact, under the principles of res judicata, reconsideration would be highly improper. As this Board stated in Ex parte Stanley, 121 USPQ 621, 624 (Board of Appeals 1958), "[t]he principle underlying res judicata is that there must be an end to litigation on an issue..." (See Exhibit 1) The issue as to whether Roberts, Berkebile and Brown '388 teach the length requirements of Appellants' claimed invention has been finally decided by this Board. (See Decision of Appeal, p. 11) All three references lack any teaching or suggestions of Appellants' claimed invention including the length limitations set forth in Claims 6, 7 and 28. The litigation on this issue must now come to an end. Otherwise patent applications could be repeatedly batted back and forth between this Board and the Examiner to the substantial financial detriment of Appellants. There is simply no room for argument that this Board's Decision on Appeal forms a basis for res judicata. Ex parte Paulus, Campbell, and Crowl, 157 USPQ 706, 707 (Board of Appeals 1967)(See Exhibit 2)


Because the issue this Board has instructed the Examiner to consider has already been finally decided by this Board, Appellants request that section IV of the Decision on Appeal be stricken in its entirety.

It is believed that no additional fee is due. Should that determination be incorrect,

however, the Commissioner is further authorized to charge any deficiency to Deposit Account No. 13-2759 and notify the undersigned in due course.

Date: 3/27/03

Respectfully submitted,


James J. Merek
Attorney for Appellants
Reg. No. 32,158

MEREK, BLACKMON & VOORHEES
673 South Washington Street
Alexandria, Virginia 22314
Telephone: (703) 684-5600